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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,810	01/10/2001	Jochen Voss	Mo-6029/LeA 34,199	7359

157 7590 08/06/2002

BAYER CORPORATION  
PATENT DEPARTMENT  
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PITTSBURGH, PA 15205

EXAMINER

RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
1711	8

DATE MAILED: 08/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	09/757,810	Applicant(s)	VOSS, JOCHEN
Examiner	Travis B Ribar	Art Unit	1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 5/31/02

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .      6) Other: \_\_\_\_\_ .

**DETAILED ACTION**

1. All objections put forth in the office action dated November 5, 2001 are overcome by the applicant's amendment filed May 31, 2002.
2. All rejections based on 35 USC 103 put forth in the office action dated November 5, 2001 are upheld.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf et al. in view of Volz and Lane et al.

The office action dated November 5, 2001 contains the text of this rejection, which the examiner includes below for the applicant's convenience.

Wolf et al. discloses a primer used for the metallization of a substrate. It teaches the substrates that may be used (column 5, lines 1-3), which include inorganic glasses, metals, and plastics. One primer composition claimed (Wolf et al., claim 2) involves a primer consisting of a film former of polyurethane.

Wolf et al. discloses a primer (Wolf et al., claim 1) comprising all elements shown in claims 1 and 3 of applicant's application, with the exception of a hydrophilic swelling agent to aid the transport of large molecules through the primer. The composition of the primer named in Wolf et al. is such that a swelling agent does not need to be present in

the primer in order for metallization to occur. The lack of a swelling agent is noted (Wolf et al., column 4, lines 64-48) in the primer, though the use of a swelling agent is not explicitly precluded. One of ordinary skill in the art would know to add a swelling agent to the primer in order to facilitate the penetration of larger molecules through the primer. Volz shows a swelling agent used to aid the penetration of large molecules through a matrix (column 2, lines 54-58).

Lane et al. shows a catalytic metal-polymer complex, or primer, capable of facilitating the electroless metallization of a substrate and further teaches that an anticaking agent may be included in the primer's composition (column 5, lines 46-49). From the context of Lane et al., it is determined that the terms 'anticaking agent' (from Lane et al.) and 'swelling agent' (from applicant's application) are synonymous and that a compound shown to perform an 'anticaking' function in the invention of Lane et al. will perform a 'swelling' function in the applicant's invention. Lane et al. shows a fumed silica such as CABOSIL used as an anticaking agent (column 5, lines 48-49). That anticaking agent is of the same type shown by the applicant to be a swelling agent (page 7 lines 6-10) in applicant's invention. The physical dimensions and attributes of the swelling agent, such as the hydrophilicity, diameter, shape, and surface area, are not shown to be unique to the composition of the primer, nor are they shown to be a product of applicant's invention and are therefore assumed to be inherent to the material. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to take the primer claimed in Wolf et al. and add a swelling agent to it

as in Lane et al. in order to increase the penetration of large molecular weight compounds, as seen in Volz and give improved adhesion.

### ***Response to Arguments***

5. Applicant's arguments filed May 31, 2002 have been fully considered but they are not persuasive.

The applicant argues that Wolf et al. teaches away from using a swelling agent in the primer composition that it claims. As evidence, the applicant points to column 4, lines 64-68 of the reference, which claims that "a swelling adhesion treatment of the plastic is not necessary," and that by avoiding such a treatment, "the formation of stress cracks is avoided." The applicant believes the plastic that Wolf et al. refers to in this passage is the primer, and as such, the addition of a swelling agent to the primer is outside the scope of Wolf et al.

The plastic that Wolf et al. refers to is not the primer, however, it is the substrate onto which the primer is coated (see column 4, lines 58-63), and the swelling adhesion treatment that the passage refers to is a method of preparing a substrate for electroless plating, not the addition of a swelling agent to the primer. Reichert et al. adequately defines swelling adhesion treatment of a substrate (column 1) and states that the method does indeed lead to stress cracking. Therefore, Wolf et al. does not teach against using a swelling agent in the primer composition, rather it states that a pretreatment of the substrate is not necessary when using the disclosed primer

composition. The addition of a swelling agent to the composition is therefore not outside the scope of Wolf et al.

6. In response to applicant's argument that Volz is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Volz is concerned with the penetration of large molecules into a polymer matrix, which is a problem with which the applicant was concerned. In addition, the examiner notes that Volz was not used to modify Wolf et al. It was only used to show that the addition of a swelling agent to a polymer composition is known to those in the polymer art to improve the penetration of large molecules into a polymer matrix and thereby provide additional motivation for the use of a swelling agent in Wolf et al. The invention is met by the combination of Lane et al. and Wolf et al., using Volz only to show what is known in the art.

7. In response to applicant's argument that Lane et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this

case, Lane et al. is in the field of the applicant's endeavor, namely electroless metallization of a substrate.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
July 29, 2002



James J. Seidlock  
Supervisory Patent Examiner  
Technology Center 1700